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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SERGEY N. RAZUMOV

Appeal 2008-3743
Application 10/762,375
Technology Center 3600

Decided: January 23, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

An oral hearing was held on Jan. 15, 2009.

DECISION ON APPEAL

STATEMENT OF THE CASE

Sergey N. Razumov (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 29-43. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.[1]

THE INVENTION

The claimed invention "relates to retail systems, and more particularly, to a multimedia terminal for enabling a customer of a retail system to place an order for a product." Specification [02].

Claim 29, reproduced below, is illustrative of the subject matter on appeal.

> 29. A system for enabling a customer to order a required product, comprising:
>
> a voice recognition mechanism for recognizing voice commands from the customer, and
>
> a display mechanism responsive to the recognized voice commands for displaying images assisting the customer in ordering the product during a product ordering session,
>
> the display mechanism being configured for displaying a first screen representing a first phase of the product ordering session and a second screen representing a second phase of the product ordering session, and
>
> the voice recognition mechanism being configured to establish a first set of voice commands recognizable when the first screen is displayed, and a second set of voice commands recognizable when the second screen is displayed.

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Dec. 13, 2007) and Reply Brief ("Reply Br.," filed Mar. 19, 2008), and the Examiner's Answer ("Answer," mailed Jan. 30, 2008).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Sturr, Jr.	US 2004/0143512 A1	Jul. 22, 2004

The following rejection is before us for review:

1. Claims 29-43 are rejected under 35 U.S.C. §102(e) as being anticipated by Sturr, Jr..

ISSUES OF LAW

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 29-43 under 35 U.S.C. §102(e) as being anticipated by Sturr, Jr.. As to claims 29 and 36, does Sturr, Jr. expressly or inherently describe a system comprising a "voice recognition mechanism for recognizing voice commands from [a] customer," which voice recognition mechanism is configured to establish a first [and second] set of voice commands recognizable "when [a] first [and second] screen is displayed" (claim 29) or "during a first [and second] phase of [a] product ordering session" (claim 36) and a display mechanism responsive to the recognized voice commands for displaying images? As to claim 40, does Sturr, Jr. expressly or inherently describe the claimed combination of executing voice commands and displaying images corresponding to those commands, as claimed?

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The independent claims are apparatus claims 29 and 36 and method claim 40.

As to claims 29 and 36, they describe a system comprising a "voice recognition mechanism for recognizing voice commands from [a] customer," which voice recognition mechanism is configured to establish a first [and second] set of voice commands recognizable "when [a] first [and second] screen is displayed" (claim 29) or "during a first [and second] phase of [a] product ordering session" (claim 36) and a display mechanism responsive to the recognized voice commands for displaying images.

We are unable to find any description of the voice recognition mechanism and display mechanism described in claims 29 and 36 in Sturr, Jr., expressly or inherently.

In support of the position that Sturr, Jr. expressly describes the voice recognition and display elements of the claimed systems, the Examiner relied on ¶¶ 0025, 0027, 0031-0033 and Figs. 1-13. We can find no mention of "voice" or a similar term in any of the Sturr, Jr. Figs. 1-13 and, as to ¶¶ 0025, 0027, 0031-0033, it is recited only once, at ¶ 0025: "Kiosk user interfaces 20 are usually offered with touch screens 28 for the customer to enter information by touching a monitor screen, *however, other means for*

entering information may also be used, including … microphones and voice recognition and response systems and other suitable means of making a selection that can be recognized by a computer." (Emphasis added.) Sturr, Jr. does not otherwise explain how the voice recognition enables the computer to make a selection or further describe an association with the monitor screen.

Thus, we do not find that Sturr, Jr.'s disclosure of using voice recognition as one of the means by which a customer can enter information into a computer to "mak[e] a selection that can be recognized by a computer" expressly describes a voice recognition mechanism *configured to establish a first [and second] set of voice commands recognizable* "when [a] first [and second] screen is displayed" (claim 29) or "during a first [and second] phase of [a] product ordering session" (claim 36) and where a display mechanism is responsive to the recognized voice commands for displaying images.

Since Sturr, Jr. does not expressly describe the claimed subject matter, it must inherently describe it to qualify as an anticipatory reference.

In that regard, Sturr, Jr. does not explain how a voice recognition mechanism would enable its computer to make a selection in association with the monitor screen. All that Sturr, Jr. discloses is a voice recognition means as an alternative to touching a screen for entering information so that a selection can be made. To operate, Sturr, Jr.'s system would necessarily need a mechanism that recognizes a customer's voice commands "when [a] first [and second] screen is displayed" (claim 29) or "during a first [and second] phase of [a] product ordering session" (claim 36). Under principles of inherency, when a reference is silent about an asserted inherent

characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). While it is fair to say that Sturr, Jr.'s computer is configured to recognize information received in a voice format from which a selection is made, such a computer would not necessarily need a voice recognition mechanism to recognize a voice command "when [a] first [and second] screen is displayed" (claim 29) or "during a first [and second] phase of [a] product ordering session" (claim 36) and a display mechanism responsive to the recognized voice commands for displaying images. While it may be quite possible to configure Sturr, Jr.'s computer to include the mechanisms claimed (and perhaps within the level of ordinary skill in the art to do so), "[i]nherency [for purposes of establishing anticipation], however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Accordingly, we find that a prima facie case of anticipation has not been established for the subject matter of claims 29 and 36, and, respectively, for the subject matter of dependent claims 30-35 and claims 37-39.

As to the rejection of method claim 40 and claims 41-43 that depend from it, the Examiner relies on the position taken with respect to the system claims. See Answer 5. The Examiner should have made a claim construction analysis of claim 40, rather than relying on an understanding of the system

claims, because method claim 40 is quite a bit broader in scope than the independent system claims 29 and 36. Claim 40 calls for a terminal that executes two voice commands and the displaying of two sets of images corresponding to the voice commands during two phases of a product ordering session. Unlike claims 29 and 36, claim 40 does not require the use of a computer display to perform the step of displaying the sets of images. Nor is there any requirement that there be a display responsive to the voice commands. Based on its broadest reasonable construction in light of the Specification as it would be understood by one of ordinary skill in the art, claim 40 encompasses a combination of a terminal (e.g., a computer) executing two customer voice commands and someone displaying two images corresponding to the voice commands, not necessarily in that order, during two phases of a product ordering session. Had the Examiner made such an analysis, perhaps the Examiner's position would have been different.

But, we are constrained to review the rejection that has been presented to us. In that regard, we are unable to find, and the Examiner has not explained, where in Sturr, Jr., expressly or inherently, the claimed combination of executing voice commands and displaying images corresponding to those commands, as claimed, is described. As a result, we are compelled to reverse the rejection on the ground that the Examiner has not met the initial burden of establishing a prima facie case of anticipation for the claimed subject matter over the teachings of Sturr, Jr.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 29-43 under 35 U.S.C. §102(e) as being anticipated by Sturr, Jr..

DECISION

The decision of the Examiner to reject claims 29-43 is reversed.

REVERSED

vsh

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